

REMARKS

1. The application was filed with 26 claims, all of which remain pending in the application. All claims remain rejected under different provisions of U.S. patent law, including 35 U.S.C. §§ 101, 102, 103(a) and 112, first and second paragraphs. Claim 15 has been amended. No new matter was entered in making this amendment.

2. Claims 23-26 are rejected under 35 U.S.C. § 101, on the grounds that the claimed invention is not seen to be "concrete," as the recited "instruction" is from a government official and appears to be a subjective evaluation, rather than a repeatable outcome. Office Action, p. 6, lines 6-8. Applicants traverse the rejection. Claims 23-26 recite process claims, for a method of processing an international traveler, including the last step of Claim 23, "sending the passenger to further processing selected from the group consisting of customs, immigration, and no further processing, depending on an instruction from the government official of the second country."

The outcome of the process of Claim 23 is repeatable, because the official can instruct the passenger to go to customs, to immigration, or to no further processing. Under the new subject matter rejection guidelines, a rejection for failure to produce a "concrete" result is only proper if the process does not have a result that is substantially repeatable, i.e., the process must substantially produce the same result repeatedly.¹ The *Guidelines* require that if the process requires a particular skill, a determination as to whether the process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in the field.² The Office Action does not include this determination, and subject matter rejection of Claims 23-26 is therefore improper. The *Guidelines* themselves require focusing not on the steps taken to achieve a particular result, but rather that the final result is "useful, tangible and concrete" (emphasis in the original).³

¹ *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, October 2005, at 22, www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf. Published at 1300 OG 142, November 22, 2005.

² *Id.*

³ *Id.* at 38.

If the objection is that the claims do not yield a sufficiently definite result, then the scope of the claims, or another portion of the patent laws may be at issue, but this should not be confused with subject matter eligibility.⁴ In this instance, Claims 23-26 constitute a new and useful process and are eligible for patenting. The Examiner is respectfully requested to withdraw the § 101 rejections.

3. The application is rejected under 35 U.S.C. § 112, first paragraph, and is objected to under 35 U.S.C. § 132 (a) on the grounds that the amendment filed on October 6, 2005, contained new matter, specifically that the specification does not support the Claim 1 amendment for a "procedure." Applicants traverse the rejection/objection. Claim 1 was previously amended to recite, "routing the passenger in the destination country in accordance with the data and ~~an instruction~~ a procedure from the government or governmental agent."

While the word "procedure" is not in the specification, one sentence in the middle of the first full paragraph on p. 11 of the application states that,

The passenger may receive routing instructions 516, such as a ticket or card that may be printed at the interface, instructing the passenger to proceed to customs or to immigration, or that the passenger is free to proceed as he or she wishes.

The passenger is routed and he may proceed as instructed. Procedure may be defined as "a particular way of accomplishing something or of acting." Merriam-Webster's Collegiate Dictionary, 10th ed. at 929. The specification states that the passenger may receive routing instructions that instruct the passenger to proceed as ordered to customs or proceed to immigration, or to proceed as desired. The claim recites that the passenger is routed in accordance with a procedure. The procedure may include proceeding to customs, proceeding to immigration, or proceeding as desired. Applicants contend that the specification has sufficient support for the amendment, and request that the Examiner withdraw the objection/rejection.

⁴ *SmithKline Beecham Corp. v. Apotex*, 74 U.S.P.Q.2d 1398 (Fed. Cir. 2005) (stating that if the subject matter of the claim is eligible under 35 U.S.C. § 101, other issues, such as claim scope, should not be raised under the guise of § 101).

4. Claims 1-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as their invention. The rejection states that the Claim 1 phrase, "in accordance with the data and a procedure from the government or governmental agent" is not supported in the specification, and that Claims 1, 13, and 14 all reference "the procedure" that is not supported by the specification.

By the arguments given above for the rejection/objection under 35 U.S.C. § 112, first paragraph, and § 132 (a), there is sufficient support in the specification for the phrase "a procedure from the government or governmental agent." The Examiner is respectfully requested to withdraw the rejections under 35 U.S.C. § 112, second paragraph.

5. Claims 15-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as their invention. Claim 15 has been amended to specify that at least one computer in the first country is linked to at least one computer in the second country for exchanging information. Support for the amendment is found at least in the specification on p. 9, lines 10-13. Applicants submit that amended Claims 15-22 are not indefinite since the computers in the first and second nations are linked.

6. Claims 1-2, 5-9, 12-13, and 15-22 are rejected under 35 U.S.C. § 102(a) as being anticipated by a magazine article by Marjo Johne, published March, 2001, and entitled, "Picking up the pace (biometric technology in air travel)" ("Marjo"). Applicants traverse the rejections because the article does not teach all the limitations of the claims. In addition, Claims 3-4 are not rejected under 35 U.S.C. § 102 or § 103(a). As admitted in the Office Action, p. 2, lines 15-17, at least Claims 3-4 are patentable over the prior art.

Claim 1

The article by Marjo mentions certain aspects of travel and biometrics but does not teach a method as recited in Claim 1. Note that the passages cited from Marjo, lines 1-19, and 47-54, do not teach or suggest the international travel limitations as claimed.

i. Marjo does not teach, for example, the Claim 1 limitation of "sending data identifying the passenger to a government or a governmental agent in a destination country." The rejection cites Marjo, page 1, lines 47-54, as teaching this step. The cited passage, however, merely states that Canadian passenger may someday be able to use Marjo's system for customs clearance. There is no teaching or suggestion of sending data identifying the passenger to a destination country, since the passage clearly states that the data will be used for customs clearance for Canadians re-entering Canada. Thus, no data need to leave Canada and no data need be sent to Canada. The passage does not teach the recited limitation.

Marjo also teaches that in the future passengers may be issued an optical memory card which can store passenger identification and information. Marjo, page 1, lines 33-35. This passage teaches that the passengers will carry the card, but does not teach or suggest the step of sending data identifying the passenger to the destination country. Accordingly, Marjo does not teach or suggest the step of sending data.

ii. The rejection offers no citation for the Claim 1 limitation of "comparing a prior image of the passenger to the first image." The rejection does cite Marjo, lines 11-19, for the later Claim 1 limitation of "comparing the second image to a prior image of the passenger," but not for the earlier step. A fair reading of Marjo, and what Marjo teaches or suggests, does not include two separate steps of comparing as recited in Claim 1. Accordingly, there is no prima facie rejection for Claim 1 since the reference does not teach or suggest all the steps of the claimed invention, and the rejection does not contend that the reference teaches all the limitations of the claimed invention.

iii. Marjo also does not teach the amended Claim 1 limitation of routing the passenger in accordance with a procedure from a government or a governmental agent. The rejection cites Marjo, p. 1 lines 12 and 47-54. The passage in line 12, however, does not teach or suggest international travel – the passage simply says that after a passenger arrives at the destination, the passenger breezes through the checkpoints and heads over to the car rental booth. This actually teaches against international travel, since many nations will not allow foreign visitors to drive a car without special permission. As for lines 47-54, Marjo simply teaches that Canadian citizens re-entering Canada can clear customs

using biometrics. This may teach nothing more than identification of the person, and does not teach or suggest routing the passenger according to a procedure from the government or governmental agent.

Thus, Marjo does not teach or suggest at least these three limitations of Claim 1. Applicants submit that Claim 1 is allowable. Claims depending from Claim 1 are also allowable, including Claims 2-14.

Claim 15

The rejection of Claim 15 on pp. 7-8 of the Office Action cites only a computer interface and a memory, a camera linked to a computer, and feature, voice or facial recognition software. See Office Action, p. 7, line 31, to p. 8, line 1. Amended Claim 15, however, recites many limitations besides the cited limitations, including a check-in counter, a customs form stored in at least one computer memory, a baggage inspection system, an immigration counter, and so on, including the added limitation that at least one computer in the first country is linked to at least one computer in the second country for exchanging information. For anticipation under 35 U.S.C. § 102, all the limitations of the claim must be found in the reference. Therefore, the Office Action does not make out a prima facie case of anticipation against Claim 15. Accordingly, amended Claim 15 is allowable since there is no prima facie anticipation of Claim 15.

Claims 16-22

The Office Action does not cite specific locations in the Marjo reference for the limitations of Claims 16-22. Claims 16-22 are allowable at least because they depend from allowable Claim 15. The Examiner is respectfully requested to withdraw the rejections of Claims 15-22.

7. Claim 10 is rejected under 35 U.S.C. § 103(a) as being obvious over a magazine article by Marjo Johnne, published March, 2001, and entitled, "Picking up the pace (biometric technology in air travel)" ("Marjo"), in view of Official Notice. The rejection states that Marjo discloses filling out forms on a computer and sending them to an agent of

the government and routing the passenger according to a government or governmental agent. The rejection takes Official Notice that it is old and well known to fill out forms and send them, and it would have been obvious to fill out a customs declaration form in Marjo's system for the benefit of increased speed of processing through the airport.

The passages cited from Marjo, lines 5-6 and 15-23, do not teach or suggest customs, nor do they teach or suggest the Claim 10 steps of filling out a custom declaration form, entering the form into a computer memory, sending the form to the government or to a governmental agency, and routing the passenger in accordance with the government or governmental agent. Accordingly, even if it is old and well known to fill out forms, the rejection does not cite, and Marjo does not teach or suggest, the other limitations of Claim 10. Even the portions of Marjo that more directly concern customs, p. 1, lines 47-54, discuss biometric identification for Canadians returning to Canada. These passages do not teach or suggest the Claim 10 limitations of computerized customs forms.

In the Amendment filed on October 6, 2005, Applicants challenged the assertion of Official Notice in the previous Office Action, mailed July 15, 2005. It is not appropriate for the Examiner to take Official Notice of facts where the facts asserted to be well-known are not capable of instant and unquestionable demonstration of being well known. M.P.E.P. 2144.03 at 2100-142 (8th ed. rev. 4). Applicants renew the traversal of this assumption.

Applicants do not claim to have invented forms, and do not claim the novelty of filling out conventional customs forms. In this instance, Applicants merely claim a novel method for expeditiously executing and forwarding a form as part of a method of quickly and expeditiously processing an international passenger. Accordingly, there is no prima facie rejection of Claim 10, which is therefore allowable.

8. Claim 11 is rejected under 35 U.S.C. § 103(a) as being obvious over a magazine article by Marjo Johne, published March, 2001, and entitled, "Picking up the pace (biometric technology in air travel)" ("Marjo"), in view of U.S. Pat. No. 6,698,653 to Mel Diamond et al. (Diamond"). Claim 11 is allowable at least because it depends from allowable Claim 1. The Examiner is respectfully requested to withdraw the rejection of Claim 11.

9. Claim 14 is rejected under 35 U.S.C. § 103(a) as being obvious over a magazine article by Marjo Johne, published March, 2001, and entitled, "Picking up the pace (biometric technology in air travel)" ("Marjo"), in view of Applicants' disclosure. The rejection cites no passage from Marjo and admits that Marjo does not teach the limitations of Claim 14. Office Action, p. 9, lines 15-17. Claim 14 is allowable at least because it depends from allowable Claim 1.

10. Claims 23-24 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Pat. No. 6,044,353 to Anthony Pugliese ("Pugliese") in view of U.S. Pat. No. 6,335,688 to Clifford Sweatte ("Sweatte"). The rejection states that Pugliese discloses all the limitations of Claim 23, except for the limitation of sending the passenger from the first country to the second country, which Sweatte discloses. The rejection also states that Pugliese discloses the limitations of Claim 24.

Applicants traverse the rejections. Pugliese does not teach or suggest at least the step of sending baggage through an electronic baggage inspection system, as recited in Claim 23. Pugliese only teaches, in the passage cited, that baggage is identified, counted, and weighed. The tags may be RFID (radio-frequency identification) tags. Pugliese does not teach or suggest inspection of baggage, and thus Claim 23 is patentable.

Claim 23 is allowable because the cited art does not disclose all the limitations of the claim. The Examiner is respectfully requested to withdraw the rejection of Claim 23. Claim 24 is allowable because it depends from allowable Claim 23.

11. Claim 25 is rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Pat. No. 6,044,353 to Anthony Pugliese ("Pugliese") in view of U.S. Pat. No. 6,335,688 to Clifford Sweatte ("Sweatte"), and further in view of Official Notice. Applicants traverse the rejection. The rejection cites Pugliese, col. 3, line 62, to col. 4 (lines not specified), as teaching or suggesting filling out a form. The paragraph which begins with col. 3, line 62, simply states that a passenger may use an automatic baggage check-in machine (ABM) which may dispense a number of baggage labels according to the number of bags which

the passenger wishes to check. The rejection evidently intends that this passage concerning baggage labels suggests "forms," because the rejection also admits that Pugliese does not disclose filling out customs declaration forms. Office Action, p. 10, lines 25-26.

Thus, the rejection admits that there is no reference that discloses the limitations of Claim 25. Instead, the rejection takes Official Notice that any type of form can be filled out and sent. Therefore, states the rejection, it would have been obvious to fill out a customs declaration form in Pugliese for the benefit of increased speed of processing through the airport.

Even if the rejection takes Official Notice that any type of form can be filled out and sent, Official Notice is not taken, and there is no teaching in Pugliese, that a customs declaration can be filled out and saved, and there is certainly no Official Notice or teaching that the form is filled out electronically. A proper combination of Pugliese and Official Notice in this instance would result in a suggestion that a baggage label may be filled out and sent. There is no suggestion of electronically saving a customs declaration.

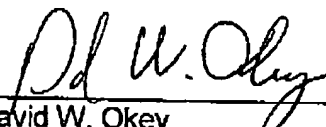
In the Amendment filed October 6, 2005, Applicants challenged the assertion of Official Notice in the previous Office Action, mailed July 15, 2005. It is not appropriate for the Examiner to take Official Notice of facts where the facts asserted to be well-known are not capable of instant and unquestionable demonstration of being well known. M.P.E.P. 2144.03 at 2100-142 (8th ed. rev. 4). Accordingly, this rejection gives the appearance that both Official Notice and hindsight are being used. Hindsight seems to be used because there is no citation in the rejection for an electronic customs form or saving a customs form electronically, and Claim 25 itself provides the mention of the customs form. Thus, the words of the application itself are being used to provide the rejection. This is hindsight.

The Office Action fails to make out a prima facie rejection because the references do not teach or suggest all the limitations of Claim 25. Claim 25 is allowable, and Applicants respectfully request the Examiner to allow Claim 25.

12. Claim 26 is rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Pat. No. 6,044,353 to Anthony Pugliese ("Pugliese") in view of U.S. Pat. No. 6,335,688 to Clifford Sweatte ("Sweatte") and further in view of Applicants' disclosure. Claim 26 is allowable at least because it depends from allowable Claim 23.

13. Applicants have shown that the claims of the present application are patentable subject matter under 35 U.S.C. § 101. Applicants have shown that the claims are in compliance with 35 U.S.C. § 112, paragraph 1 and § 132(a), and are not indefinite under 35 U.S.C. § 112, paragraph 2. Each of Claims 1-26 includes at least one limitation not taught or suggested in the cited art. The Office Action admits that at least Claims 3 and 4 are patentable over the prior art. The claims of the application are allowable, and the Examiner is requested to reconsider the application and to allow the claims.

Respectfully submitted,



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